

No. 14,617

United States Court of Appeals  
For the Ninth Circuit

UP-RIGHT, INC., a corporation, and  
WALLACE J. S. JOHNSON,  
*Appellants,*

VS.

PATENT SCAFFOLDING CO., INC.,  
a corporation,  
*Appellee.*

Appeal from the United States District Court for the  
Northern District of California,  
Southern Division.

REPLY BRIEF OF APPELLEE,  
PATENT SCAFFOLDING CO., INC., A CORPORATION.

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No. 14,617

# United States Court of Appeals For the Ninth Circuit

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|--------------------------------------------------------------------------------------------------------------------------------|---|----------------------------------------------------------------|
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|--------------------------------------------------------------------------------------------------------------------------------|---|----------------------------------------------------------------|

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Appeal from the United States District Court for the  
Northern District of California,  
Southern Division.

REPLY BRIEF OF APPELLEE,  
PATENT SCAFFOLDING CO., INC., A CORPORATION.

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## STATEMENT.

The appeal herein is by plaintiffs from the judgment for defendant adjudging the Johnson patent No. 2,618,496, to be invalid, entered on the decision and findings of Judge Louis E. Goodman.

The action herein is at law for damages for infringement of the said Johnson patent, granted No-

vember 10, 1952. The original complaint was filed in December, 1952, long after defendant's first sale of its device, later charged to infringe, without any prior notice to defendant of any kind—plaintiffs' devices being unmarked as to patent pending, or with the patent notice. Failure in the original complaint to allege notice was fatally defective to maintaining an action at law for damages. So, plaintiffs had to file an amended complaint alleging therein for the first time notice which was given only by the commencement of the action.

In the answer to the amended complaint, it was asserted that the patent in suit was void for lack of invention (Par. 11, R. 12), invalid for lack of patentable combination (Par. 6, R. 10), that the question in this case is one of law and not of fact; that there cannot be a conflict as to the facts in view of the simplicity of the structures, and that damages must be proven. (Par. 9, R. 11.) See *Benfield v. Potts & Co.* (CCA 6), 126 Fed. 475 at p. 485.

The principal defense was that said patent was invalid because the essential elements of the single claim were well known in the prior art, with nothing new in their functioning added. (R. 16-20.) Defendant's evidence was directed entirely to this issue and consisted of references to and analysis of the prior art patents (R. 292-346, 123-155), other than those mentioned as "File Wrapper References" of the patent in suit (R. 235). The *prima facie* presumption of validity otherwise attaching to the patent in suit was thereby eliminated from this case. See *Stoody v.*



*Mills Alloys, Inc.* (9th Cir.), 67 F. 2d 807. On this evidence the Court below held that “all of the elements aggregated by plaintiffs’ function as taught in the prior art patents”, that “plaintiffs did not change nor bring to light anything new in the functioning of these elements” (R. 13-14), and then concluded that “the result is aggregation and not a patentable combination”. (R. 14.) The foregoing determination is amply supported by the facts as to the prior art found in patents long antedating the patent in suit and by the law applicable thereto.

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**PLAINTIFFS HAVE FAILED TO COMPLY WITH RULE 19(6),  
RULES OF U. S. COURT OF APPEALS FOR THE NINTH  
CIRCUIT.**

Appellants’ Statement of Points (R. 228) under this rule is confined to general assertions that the District Court erred: (1) “in holding” the patent in suit “invalid and void”; (2) “in not holding” it “good and valid”; (3) “in not holding” infringement by defendant; (4) “in holding” plaintiffs “not entitled to recover damages”; and (5) “in not granting” the prayed for relief. This amounts to nothing more than saying that the judge erred in holding the patent invalid. Appellants’ failure to specify the points upon which they rely upon this appeal is not cured by the recital of “Specification of Errors” for the first time in their brief on appeal. (Pl. Br. 6-8.) Nor have appellants complied with Rule 19(6) requiring that they designate the parts of the record which

they think necessary for consideration of their points. These omissions have been held fatal. (*Humphreys Gold Corp. v. Lewis*, 9th Cir., 90 F. 2d 896, 898-9; *Bank of America v. Commissioner of Internal Revenue*, 9th Cir., 126 F. 2d 48, 52; *Mutual Life Insurance Co. v. Wells Fargo*, 9th Cir., 86 F. 2d 585, 587; *E. R. Squibb & Co. v. Mallinckrodt Chemical Works*, 8th Cir., 69 F. 2d 685, 687.)

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#### DEFENDANT-APPELLEE'S POSITION.

It is contended for the appellee:

(1) The language of the claim herein does not set forth any patentable combination.

(2) The patent claim herein does not set forth any structural features constituting invention, in the light of the prior art.

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#### THE ELEMENTS OF THE CLAIM IN SUIT.

The Johnson patent in suit sets forth in its single claim the following four elements:

(1) *A vertical tubular outer supporting leg member (16) terminating at its lower end in a plurality of downwardly extending outwardly radially biased resilient fingers (20) integral therewith;*

(2) *An inner member (17) telescopically received within the outer member (16), said inner member (17) having an upper cylindrical bearing portion (23) engaging a complementary portion of said outer*

supporting leg member (16) and having an externally threaded lower portion (threads 17a);

(3) *A segmental internally threaded nut (21) fixedly secured to said fingers (20) for threaded engagement with the threaded portion (threads 17a) of the inner member (17) when the fingers (20) are forced inwardly; and*

(4) *A collar (24) on the outer member (16) movable relative to the nut (21) to force the fingers (20) inwardly to place the nut (21) into threaded engagement with the threads (17a) of the inner member (17) and to retain such engagement until the collar (24) is moved relative to the nut (21) to permit the fingers (20) to move radially outwardly, the length of the threaded portion of the inner member (17) being substantially greater than the length of the threaded portion of the nut (21).*

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THE PRIOR ART PATENTS SHOW EVERY ELEMENT OF THE CLAIM, WORKING IN THE SAME WAY AND PRODUCING THE SAME RESULT.

The practical art utilized a cylindrical bearing portion on an inner leg member engaging a complementary portion of an outer supporting leg member to prevent lateral deflection, as in the Uecker patent No. 2,203,114. (Def. Ex. E; R. 301; Findings VII, XII and XVII; White Test. R. 128.) The said Uecker patent also preempts the novelty of an adjustable leg for a scaffold structure (as does also Uecker patent No. 2,043,498; R. 250). The adding

of the split nut of Michelin patent No. 750,675 (Def. Ex. L; R. 334), by one skilled in the art, to obtain a fine and coarse adjustment to the anti-wobbling device of Uecker No. 2,203,114 (Def. Ex. E), is a substitution, following the process of reasoning of any good mechanic without more.

Split fingers on a slotted outer tubular leg, engaging a telescopic inner leg member with a clamping ring readily substitutable for the screw connection of Uecker, were disclosed prior to the patent in suit by Athans No. 1,679,017. (Def. Ex. D; R. 293; Findings VII, XII, XIII and XIV; White Test. R. 123.) Also prior are many collar controlled inwardly threaded split nuts engaging outwardly threaded telescopic inner members, as in the simple connection of the Countryman patent No. 1,912,475 (Def. Ex. F; R. 305; Findings VII, XII, XIII, XIV, XV and XVIII; White Test. R. 129), which, in Figs. 6 and 7, present every element of the combination (R. 171) and which has both coarse and fine adjustments.

Of such common knowledge is an interiorly threaded jaw engaging a telescopic outwardly screw-threaded inner member within the confinement of a clamping collar, generally called in this case a "split nut," that it found application to calipers as early as 1886 in Stevens No. 351,474 (Def. Ex. I; R. 324); Findings VII, XIII, XV and XVIII; White Test. R. 140); to a yoke, as in Mapes No. 654,512 (Def. Ex. M; R. 339; Findings VII, XV and XVIII; White Test. R. 154); to a screw clamp, as in Taylor No. 747,270 (Def. Ex. G; R. 315; Findings VII, XV

and XVIII; White Test. R. 153); and to gun wipers, as in Birch No. 210,235 (Def. Ex. K; R. 331; Findings VII and XV; White Test. R. 143). In all of these, the inner leg member may be moved any spaced distance when the threaded jaws are open, until they are again closed.

Unrestrained vertical adjustability of mechanically cooperating parts, such as an internally threaded split nut for threaded engagement with an externally threaded inner member, and having the same function and results as the corresponding element claimed in the patent in suit, is also found in Hinckley, showing a mechanism for operating and feeding oil well drills, including:

(1) The telescoping of one member into the other, the outer leg member B terminating in a plurality of extending resilient fingers at its lower end and integral therewith (B with fingers C integral therewith);

(2) An inner member A received within the outer member B having a bearing portion (the portion e) engaging a complementary portion of the outer leg member B and having an externally threaded lower portion A;

(3) A split internally threaded nut inside fingers or jaws C fixedly secured to said fingers or jaws C for threaded engagement with the threaded portion of the inner member A (the nuts are part of the end of B immediately below the reference character C when the fingers or jaws C move inwardly); and



(4) A collar a, on the outer member movable relative to the nut to force the fingers inwardly to place the nut into threaded engagement with the threads of the inner member and to retain such engagement until the collar a is moved relative to the nut to permit the fingers or jaws C to move radially outwardly, the length of the threaded portion of the inner member being substantially greater than the length of the threaded portion of the nut (see Findings VII and XV; White Test R. 135-137).

The Hinckley structure permits a coarse and a fine adjustment (R. 139).

The cylindrical bearing portion of the inner supporting leg member of the claim in suit is also clearly disclosed in the Moore patent No. 2,184,358 (Def. Ex. N; R. 344). In the Moore structure, the bearing portion 19 of the inner leg member engages a complementary portion of the outer leg member, the inner leg member also being engageable by the split and slotted collar having radially contractible and expansible jaws (Rec. p. 345, Col. 1, lines 47-53). Thus, the cylindrical portion 19 of the Moore patent is the anti-wobbler device, and the mechanism 13 is the jaw-clutch device (Findings VII, XII, XIII, XVI and XVII, White Test. R. 150-152), each operating separately from the other. Moore recites, in claims 3 and 4 (R. 346), that "the exterior diameter of the inner member for the major portion of its length being less than the interior diameter of the outer member" (line 21); and, as is clearly shown in the

drawing of this Moore patent, the recited major portion is the lower portion of the inner member—exactly as in the structure of the claim in issue. The patentee also there states (R. 345, Col. 2, lines 31-34) that “Preferably element 19 [the enlarged upper portion of the inner leg member] has a snug sliding fit within [outer] leg member 6 and cooperates therewith for guiding and bracing the leg members 6 and 7.” In other words, this Moore patent provides a structure which permits rough vertical adjustment and, at the same time, prevents lateral wobbling. Since, for example, Michelin patent No. 750,675 (Def. Ex. L; R. 334; Findings VII and XV; White Test. R. 144) shows the split nut locking structure of Johnson, the substitution of the Michelin split nut for the Moore split collar is obvious to any mechanic skilled in the art. This is especially significant in view of appellant’s conceding the antiquity of all the elements of the claim in their construction, stating “each individual mechanical part of which is found to be separately old in various prior art devices.” (Brief, p. 5.)

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## ARGUMENT.

### I.

#### THE LANGUAGE OF THE CLAIM HEREIN DOES NOT SET FORTH ANY PATENTABLE COMBINATION.

Before this Court reaches the question of “invention,” we submit it should consider whether a patentee must show that there is present such assemblage

of mechanical parts which cooperate under known rules of law as to establish a combinative subject matter. Merely placing such parts into juxtaposition, allowing each part to work out its own law of action separately from and independently of the other, in non-unitary functions, means, and result, is like an eraser at the end of a pencil. It is as empty of result in patent law as proof at trial by incompetent evidence, which is no evidence at all, and which is not entitled to any consideration, whether or not the question of competency has been raised.

While the claim of the patent in suit (Pl. Ex. 1; R. 231) presents a leg structure, to-wit, the elongated inner member having a cylindrical bearing, and an enclosing structure which prevents wobbling, and, elsewhere, a split nut clutch structure engaging the exteriorly threaded leg, it is significantly silent as to any mechanical cooperation between those structures. Quite obviously, the elongated bearing, to give greater bearing surface to prevent wobbling, is a mechanical structure which operates entirely independently of any clutch action to clamp the outer leg member to the inner leg member; and the clamping or unclamping of the split nut certainly does not require an elongated bearing for the leg. These are two entirely different categories of structure, and their assemblage can only be a mere addition of the function of the respective structures, each operating as if the other were not present. There is no merging of such functions, inseparably coupling the functions into a resulting force. This complete independence and non-unitary action of structural functions, each



function like that in the prior art, results in the failure to bring into being a "combination."

In the single claim of the patent in suit, there is absence of patentable "combination." The claim was for an adjustable leg, on the fallacious assumption that an adjustable leg was new *per se*. Adjustable legs have long been known. There is, therefore, no physical structure set forth in the claim conforming to the requirements of a combination. In the absence of a combination, it is not necessary to consider the question of invention.

The mere addition of the old anti-wobbler device to the old clutch device fails to present a patentable invention. Just as in the rubber tip lead pencil case (*Reckendorfer v. Faber*, 92 U. S. 347), where the rubber merely acted as an eraser, and the pencil merely as a writing instrument unaffected by the eraser, so here the old collar-controlled jaws engage the outwardly threaded inner leg member to lock the inner leg member in position, working the same way for different adjustments whether the old anti-wobbling unthreaded portion of the inner leg member is present or not. Either might have been claimed, if new; but there is no patentable combination in the addition of one to the other.<sup>1</sup>

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<sup>1</sup>"\* \* \* They performed no joint function. Each served as separately it had done. The patented device results from mere aggregation of two old devices, and not from invention or discovery." (*Toledo Pressed Steel Co. v. Standard Parts*, 307 U.S. 350, 356, 87 L. Ed. 1334, 1338.)

"The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of

## II.

We have heretofore segregated in their respective categories the mechanical elements of the patent in suit and of each prior art patent (Findings XV-XIX; R. 18-20). Where, as here, such facts are not disputed, there can be no issue of fact. By anticipation the patent in suit becomes invalid without more, as being within a suitable range of equivalents (See Finding VII of the Findings of Fact; also Section 103 of the New Patent Act).

Assuming without conceding that there is a difference between the structure of the claim of the patent in suit and the structures of the prior art, does such difference constitute invention or mere mechanical skill?

Assuming that this Court reaches the question of invention, there follows the need for selecting the applicable legal principles from a galaxy of rules of long acceptance. The mere carrying forward of the original thought, a mere change in proportions or degree, is not invention. Merely exercising the skill of the calling, or simple reasoning within the calling is not invention, since a new effect in kind is not pre-

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its parts is the accumulation of the old devices patentable.” (*Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152, 95 L. Ed. 162, 166.)

“\* \* \* patented device results from mere aggregation of two old devices, and not from invention or discovery.” (*Simplex Wrapping Mach. Co. v. Schultz et al.* (CCA 9, 1942), 128 F. 2d 138, 140.)

sented.<sup>2</sup> One cannot withdraw a thing from the circle of what was known before, which belongs to the public, and interdict its use by the public. Adjustability is not invention (*Peters v. Hanson*, 129 U. S. 541, 32 L. Ed. 742). A new use of the same structure as disclosed in the prior art is not invention (Justice Story in *Bean v. Smallwood*, 2 Story 408; *Fernandez v. Phillips* (9th Cir.) 136 F. 2d 404, 406).

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2“‘It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures.’” (*Atlantic Works v. Brady*, 107 U.S. 192, 199, 27 L. Ed. 438, 441.)

“‘Within the rule laid down by this court in *Hollister v. Benedict Mfg. Co.*, 113 U.S. 59, there was nothing more than mechanical skill in arriving at the alleged invention, in view of the state of the art. \* \* \* The principle deductible from these cases \* \* \* is that it is not a patentable invention to apply old and well known devices and processes to new uses, in other and analogous arts.’” (*Lovell Manufacturing Co. v. Cary*, 147 U.S. 623, 635, 636, 637, 37 L. Ed. 307, 311, 312.)

“\* \* \* Under the statute (35 USCA Sec. 31, RS Sec. 4886) the device must not only be ‘new and useful’, it must also be an ‘invention’ or ‘discovery’. *Thompson v. Boisselier*, 114 U.S. 1, 11. Since *Hotchkiss v. Greenwood*, 11 How. (U.S.) 248, 267, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. (Citing cases.) ‘Perfection of workmanship, however much it may increase the convenience, extend the use, or diminish expense, is not patentable.’ *Reckendorfer v. Faber*, 92 U.S. 347, 356, 357. The principle of the *Hotchkiss* case applies to the adaptation or combination of old and well known devices for new uses. *Phillips v. Detroit*, 111 U.S. 604; *Concrete Appliances v. Gomery*, 269 U.S. 177; and other cases cited. That is to say, the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.” “More must be done than to utilize the skill of the art in bringing old tools into new combinations.” (*Cuno Engineering Corp. v. Automatic D. Corp.*, 314 U.S. 84, 90, 86 L. Ed. 58, 62, 63.)

“Lack of patentable invention is here plain and commercial success, however great, cannot serve to sustain the patent.” (*Fernandez v. Phillips et al.* (9th Cir.), 136 F. 2d 404, 406.)

Appellants persist in arguing as if the features of their completed commercial product—the aluminum rolling ladder-type scaffold—were coextensive with the claim of the patent in suit and attributing thereto the alleged commercial success thereof (Brief, pp. 3, 9, 10-18; but see R. 89-90). However, their completed commercial product admittedly has many more features—all within the realm of common mechanical skill—than those set out in the rather limited patent claim herein. In fact, it embodies all the features of their earlier patent No. 2,438,173, involved in prior litigation, wherein these plaintiffs claimed great success for their aluminum collapsible ladder-type rolling scaffold, without the “gadget” of the patent in suit (R. 72-89; see, also, *Upright v. Patent Scaffolding Co., Inc.*, U.S.D.C. Civil Action 229484). So, it does not seem reasonable to attribute commercial success to the “gadget” of the patent in suit merely because it was part of the entire aluminum scaffold.

Obviously, it is the claim itself which is controlling in the determination of the controversy herein, and which alone was and could be the deciding factor before the court below. So, the enumeration by Johnson of various features of the completed commercial structure (Brief, pp. 11-13) and the elaborate argument of their counsel based thereon, with the constant reiteration of such terms and phrases as “patented structure” (Brief, pp. 5, 8, 9, 10, 13, 14), “patented device” (Brief, pp. 10, 27), “new functions” and “new results” (Brief, p. 17), “new entity” (Brief, pp. 5, 27), “new unitary result” (Brief,



p. 42), without being specific, is really the setting up of a straw man, destroyed by simple reference to the language of the claim of the patent herein. In the light of the prior art, it is apparent that appellants merely selected desirable features or expedients old in the art and incorporated them in a single device without the exercise of the inventive faculty or the production of any new or unexpected result.

Much is made of the "functions" and "results" of appellants' assemblage (Brief, pp. 16-17). However, the most that can be and is claimed by appellants is some saving in time in adjusting the leg (Brief, p. 16 bot.), but no other advantage. Such was the fact in the non-invention *Lane-Wells* case, referred to by appellants (Brief, p. 41). Appellants cannot escape the lower court's conclusion that there was nothing new in the "functions" and "results" of each of the elements of their claim, conceded to be old, for it is apparent that a construction in which the threaded jaws, moved by the collar against the threaded inner spindle, hold the spindle from falling out and allow for a fine adjustment between the threaded portions, really provides for no more than is inherent in every screw threaded connection.

The hornbook formula, new construction, new function and new result, frequently repeated in appellants' brief, lacks evidentiary support in the Record. Old devices put to a new use are of no value in contributing to the question of invention. So, there is no evidence in this case to support the many formulary statements made, the argumentative assertions being

free from references to the Record. Johnson's "requisites" for appellants' device (Pl. Br., p. 11) reveal the mind of a designer or mechanic and not the imagination of an inventor. Neither is there evidence to support such statements in the Brief as "new conception" (p. 3), "customers demanded it" (pp. 3, 9), "an innovation" (p. 5), "long standing void" (p. 8), "immediate success" (pp. 8, 10), "new abilities" (pp. 5, 43).

Appellants' criticism of the lower court for not saying the unnecessary is unfounded (Brief, pp. 4, 8 and 25).

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### CONCLUSION.

Over the years the Supreme Court has clearly set forth with constancy the standards of invention which must be met to sustain a patent for a combination of old elements. Invention, as distinguished from mechanical skill, is a requisite.

1. Where, as in the present case, all of the elements making up the claims are old and long known, the assemblage of such elements must produce some new or different functions of the elements, and a novel result as the joint product of the assemblage, otherwise there is no patentable combination and the patent is invalid.<sup>3</sup> The various elements of the Johnson claim are found in the prior art doing the same

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<sup>3</sup>*Adams v. Bellair Stamping Company*, 141 U.S. 539, 542, 35 L. Ed. 849, 851; *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Co.*, 340 U.S. 147; *Reckendorfer v. Faber*, 92 U.S. 347, 357, 23 L. Ed. 719; *Hailes v. VanWormer*, 87 U.S. 353, 368, 22 L. Ed. 241; *Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co.*, 174 U.S. 492, 498, 43 L. Ed. 1058; *Lincoln Engineering Co. v.*

work as they do in the patentee's assemblage. Telescoping leg members are found in Athans, Countryman, Moore and both Uecker patents; the resilient fingers on the outer telescopic leg member are disclosed in Athans; a cylindrical bearing portion on the inner leg member is found in Moore and Uecker 2,203,114; the split nut-contracting collar combination is found in Countryman, Michelin, Moore, Hinckley, Burns and Stephens. Each element of the Johnson aggregation and its corresponding device of the prior art function in identically the same manner, with nothing new added by Johnson to the sum total of the parts.

2. There is no invention in the mere aggregation of a number of old parts or elements, nor in the accumulation of old devices which do not in some way exceed the sum of its parts.<sup>4</sup> No new function or result follows from Johnson's aggregation, each element functions in its accustomed manner in the assemblage, and "the whole does not exceed the sum of its parts."

3. To be a patentable combination an assemblage of old devices or elements must create what had not

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*Stewart-Warner Corp.*, 303 U.S. 545, 549, 82 L. Ed. 1008; *Grinell Washing Machine Co. v. Johnson Co.*, 247 U.S. 426, 62 L. Ed. 1196; *Dallas Machine & Locomotive Works v. Willamette-Hyster Co.* (9th Cir.), 112 F. 2d 623, 627; *Himes v. Chadwick* (9th Cir.), 199 F. 2d 100, 106; *Kwikset Locks v. Hillgren* (9th Cir.), 210 F. 2d 483, 486.

<sup>4</sup>*Great Atlantic & Pacific Tea Co. v. Supermarket etc.*, 340 U.S. 147, 152, 95 L. Ed. 162; *Lincoln Engineering Co. v. Stewart-Warner*, 303 U.S. 545, 549, 82 L. Ed. 1008; *Pickering v. McCullough*, 104 U.S. 310, 318, 26 L. Ed. 749; *Himes v. Chadwick* (9th Cir.), 199 F. 2d 100, 106; *Kwikset Locks v. Hillgren* (9th Cir.), 210 F. 2d 483, 486.

before existed to bring about what lay hidden from vision in a way that can be distinguished from mechanical skill.<sup>5</sup> Johnson's aggregation has not created something which did not exist previously. Athans, Moore and Countryman all show supporting legs having relatively adjustable inner and outer telescopic leg members secured in fixed positions by clutch means. Even the specific type of clutch means used by Johnson was well known long prior to his filing date. Again Johnson has failed to meet the test of a patentable combination required to sustain validity.

4. A mere advance in efficiency and utility is not sufficient to convert a non-inventive aggregation into a patentable combination.<sup>6</sup> Nor is the mere exercise of the skill in the calling, or an advance plainly indicated by the prior art.<sup>7</sup> Nor is the mere carrying forward or more extensive application of the original thought, a change in form, proportions or degree, or doing substantially the same thing in the same way by substantially the same means with better results.<sup>8</sup>

5. The mere application of a mechanical equivalent found in the prior art to another use is not in-

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<sup>5</sup>*Hollister v. Benedict & Burham Mfg. Co.*, 113 U.S. 59, 72, 28 L. Ed. 901; *McClain v. Ortmyer*, 141 U.S. 419, 427, 35 L. Ed. 800; *Kwikset Locks v. Hillgren* (9th Cir.), 210 F. 2d 483, 486.

<sup>6</sup>*Smith v. Nichols*, 21 Wall. 112, 88 U.S. 112, 119, 22 L. Ed. 566; *Grant v. Walter*, 148 U.S. 547, 37 L. Ed. 552; *Kwikset Locks v. Hillgren* (9th Cir.), 210 F. 2d 483, 486.

<sup>7</sup>*Altoona v. American et al.*, 294 U.S. 477, 79 L. Ed. 483; *Electric Cable Joint Co. v. Brooklyn Edison Co.*, 292 U.S. 69, 79, 80; *Smith v. Magic City*, 282 U.S. 784, 75 L. Ed. 707.

<sup>8</sup>*Smith v. Nichols*, supra; *Bingham Pump Co., Inc. v. Edwards* (9th Cir.), 118 F. 2d 338, 340; *Wilson-Western Sporting Goods Co. v. Barnhart* (9th Cir.), 81 F. 2d 108, 110.



vention.<sup>9</sup> Utilizing the well known split nut-contracting collar,—a common expedient found extensively in the prior art—to secure the adjustable telescoping inner and outer leg members of Athans against relative displacement does not amount to a patentable combination, nor would the lengthening of Michelin's outer telescopic member, as taught by Athans, Countryman, and Moore, attain the dignity of a patentable invention.

6. In this case there is no presumption of the validity of the appellants' patent for the reason that the file wrapper of the patent in suit indicates that the prior art proven in this case by the defendant was not before, nor was it considered by the Patent Office examiner.

The judgment herein should be affirmed.

Dated, San Francisco, California,  
July 25, 1955.

Respectfully submitted,

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<sup>9</sup>*Vandenburg v. Truscon Steel Co.*, 261 U.S. 6, 15, 67 L. Ed. 507, 512; *John Bean Mfg. Co. v. Creagmile* (9th Cir.), 123 F. 2d 182, 185; *Roberts v. Ryer*, 91 U.S. 150, 157, 23 L. Ed. 267; *Concrete Appliances Co. v. Gomery*, 269 U.S. 177, 185, 70 L. Ed. 222; *Miller et al. v. Force et al.*, 116 U.S. 22, 29 L. Ed. 552; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U.S. 485, 493, 44 L. Ed. 586.

